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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,240	03/28/2002	Kazuhiko Ooga	Q63840	4544
23373	7590	04/01/2004	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			ZALUKAEVA, TATYANA	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,240

Applicant(s)

OOGA ET AL.

Examiner

Tatyana Zalukaeva

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-6 have been cancelled and claims 7-13 have been amended.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 7, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Trapasso et al (U.S. 5,498,751)

Trapasso discloses a product suitable for optical lens (col.1, line 23) obtained by transesterification, and a transesterification method comprising transesterifying the esters of carboxylic acids with 1,2- and 1,3- polyols selected from aralkyl polyols (claim 1). When transesterification occurs, not only aromatic polyols, but aromatic alcohols can be used for transesterification (claim 31, 61). In all cases transesterification occurs in the presence of organotin compounds (abstract, claim 38). Benzyl alcohol is clearly named as an alcohol for transesterification in claim 62, line 4 of col.20. The carboxylic acid is selected from mono-d- and tricarboxylic acids, wherein **benzene tricarboxylic acid** is named in col. 20, line 16, and allyl and methallyl alcohol used for esterification is named in col.20, line 11. The property recited in the instant claim 10 is inherent, since the composition of Trapasso is identical to the instantly claimed composition, as per claim 7, and is made by essentially the same process, as the composition of claim 7.

4. Claims 7, 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenquist (U.S. 4,701,516)..

Rosenquist discloses esters of trimellitic (benzene tricarboxylic acid) . Such Example 1 describes a procedure, wherein reaction vessel there is charged equimolar proportions of trimellitic anhydride and benzyl alcohol in methyl isobutyl ketone. The charge is heated to reflux temperature (circa 150.degree. C.) for about 60 minutes. At the end of this time period an aliquot of the reaction mixture shows an absence of anhydride by infra-red analysis. The solvent is removed under vacuum to obtain a white powder which is the benzyl ester of 1,2,4-benzene tricarboxylic acid (infrared absorption at 1735 cm.sup.-1 and 1705 cm.sup.-1). Preparation 2, wherein the procedure of Example 1 is repeated except that the benzyl alcohol as used therein is replaced with an equal proportion of allyl alcohol, neopentyl alcohol, isopropyl alcohol, cyclohexanol, or 4-tert-butylcyclohexanol, respectively, to obtain the corresponding ester of 1,2,4-benzene tricarboxylic acid. (see col. 8, lines 53-68, col.9, lines 1,2). The composition can be cured at a temperature of 200-300C for a period of time 5-30 minutes. The "viscosity" as used in the instant claim 10, which is a value measured by a rotational viscometer and the details of the rotational viscometer, is believed to be inherently the same in Rosenquist, since Rosenquist discloses essentially the same composition prepared by essentially the same process, as the instantly claimed composition.

In the instant case B it is noted here that the preamble in the present composition claims recites a statement of intended use or purpose, and does not limit the scope of

the claim, since the statements in preamble merely define the context in which the invention operates, *DeGeorge v. Bernier*, 226 USPQ 758,761, n.3 (Fed.Cir. 1985).

5. Claims 7-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Uchida et al (U.S. 5,218,067).

An allyl ester oligomer composition having a viscosity of 200 to 50,000 cP at 30.degree. C. and a refractive index of 1.50 to 1.57 at 30.degree. C., which is formed by mixing (a) 20 to 90% by weight of an allyl ester oligomer, (b) 10 to 80% by weight of at least one polyvalent allyl ester monomer selected from the group consisting of diallyl phthalate, diallyl isophthalate, diallyl terephthalate, diallyl adipate, triallyl (iso)cyanurate and **triallyl trimellitate (which is a compound of the instant claim 7)**, and (c) up to 40% by weight of at least one monofunctional polymerizable monomer selected from the group consisting of vinyl benzoate, allyl benzoate, phenyl (meth)acrylate and benzyl (meth)acrylate. A radical curing agent may further be incorporated in the composition of the present invention. Any radical polymerization initiators capable of generating radicals under irradiation with heat, can be used as the curing agent.

Practically, a percarbonate customarily adopted for polymerization of CR-39, such as diisopropyl peroxydicarbonate, di-n-propyl peroxydicarbonate or di-sec-butyl peroxydicarbonate, is used in an amount of **1 to 10 parts by weight per 100** parts by weight of the polymerizable composition, and an organic lens or the like is preferably prepared by carrying out a cast polymerization at 30-100 C(col.5, lines 15-33). This reads on the limitations of the instant claims 8, 9, 11, 12. The initiator can be

incorporated over the period of 16 hours (This in combination with the above reads on the limitations of the instant claim 13). The viscosity of Uchida's polymers are within the range as per claim 10 (Table 1, col.7, 8).

Response to Arguments

6. Applicant's arguments filed 01/20/2004 have been fully considered but they are not persuasive.

With regard to Trapasso and Rosenquist Applicants argument resides in contention that neither Trapasso nor Rosenquist disclose all elements of the claimed invention as set forth in amended claim 7. Specifically, neither Trapasso nor Rosenquist disclose a plastic lens composition as presently claimed. This is not found persuasive for the following reasons: a) Trapasso discloses a product suitable for optical lens (col.1, line 23) obtained by transesterification.

b) It is the Examiner's opinion that the preamble language **does not provide the antecedent basis for terms in the body of the claim.**

- It is the Examiner's opinion that the language of the body of the claim set out the complete invention.
- It is the Examiner's opinion that the preamble language merely provides a statement of purpose or intended use.
- It is the Examiner's opinion that the preamble language is not essential to understand **limitations and/or terms in the claim body.**

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The reference to Ooga has been withdrawn from the scope of 35 USC 102 rejection in light of the present amendment to claims 7-13.

7. At this time the rejection has NOT BEEN MADE FINAL, since the claim 13 previously has been unintentionally omitted.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (571) 272-1303. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 23, 2004

Tatyana Zalukaeva
Primary Examiner
Art Unit 1713


Tatyana Zalukaeva, Ph.D.
Primary Examiner
Art Unit 1713